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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,238	09/25/2001	Kevin McCarthy	367.40675X00	5762

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EXAMINER

ENG, GEORGE

ART UNIT PAPER NUMBER

2643

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/961,238

**Applicant(s)**

MCCARTHY ET AL.

**Examiner**

George Eng

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-37 is/are pending in the application.
- 4a) Of the above claim(s) 15-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office action is in response to the amendment filed 2/28/2005. Accordingly, applicant cancels claims 1-14 and adds new claim 15-32. However, there were 19 claims in accordance with the preliminary amendment filed 9/25/2001. Thus, the numbering of new claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Misnumbered new claims 15-32 have been renumbered 20-37. As a result, claims 15-37 are pending for examination.

### ***Claim Objections***

2. Claims 15-19 are objected to as being in improper form because depending on canceled claim. Accordingly, the claims 15-19 not been further treated on the merits.

### ***Drawings***

3. The amended drawings were received on 2/28/2005. These drawings are acceptable.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 20-35 and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Holmstrom et al. (US PAT. 6,198,939 hereinafter Holmstrom).

Regarding claim 20, Holmstrom discloses a communication terminal (10, figure 1) having at least a function for searching available menu items, comprising a user interface which a user interacts with the communication terminal, the user interface including a display (30, figure 1) and a keypad (50, figure 1), a processing means controlling the communication terminal including the user interface, and a menu search state which is entered upon requested from the user (figure 3 block 308) wherein the processing means display an invitation for entering search criteria in the display when entering the menu search state, whereupon the user enters a character string containing one or more character via the keypad (figure 3 blocks 311-312), the processing means automatically looks to match the enter search criteria to menu items from the available menu items, and the processing means presents a list of menu items matching the entered , i.e., a group of commands or functions beginning with that initial, and offers the items listed to the user for selection and execution by the user (col. 3 line 50 through col. 5 line 67 and col. 6 line 28 through col. 7 line 7).

Regarding claim 21, Holmstrom discloses the characters string consisting of alphanumeric characters (figure 3 blocks 311-312 and col. 6 lines 8-13 and lines 33-40).

Regarding claims 22-23, Holmstrom discloses the communication terminal being a mobile terminal, i.e., a mobile phone (figure 1 and col. 3 lines 50-57).

Regarding claim 24, the limitations of the claim are rejected as the same reasons set forth in claim 20.

Regarding claims 25, Holmstrom discloses the first means including a keypad including an alphanumeric key (50, figure 1) and soft-keys (51-55, figure 1) including a navigation key, and a display (30, figure 1).

Regarding claim 26, Holmstrom teaches the second means including a processor to monitor activity in the communication terminal and control the display in response thereto, wherein the processor inherently runs on a program stored in memory (col. 4 lines 38-54).

Regarding claims 27-30, the limitations of the claims are rejected as the same reasons set forth in claims 22-23.

Regarding claim 31, Holmstrom discloses that the available menu items being stored in a memory of the communication terminal (col. 4 lines 19-26).

Regarding claim 32, the limitations of the claim are rejected as the same reasons set forth in claim 20.

Regarding claim 33, Holmstrom discloses the menu items being arranged by the processor alphabetically on a display of the communication terminal (figure 5 blocks 510-514 and col. 6 lines 40-44).

Regarding claims 34-35, the limitations of the claims are rejected as the same reasons set forth in claim 25.

Regarding claim 37, the limitations of the claim are rejected as the same reasons set forth in claim 26.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holmstrom et al. (US PAT. 6,198,939 hereinafter Holmstrom) in view of Pisutha-Arnond et al. (GB 2345227 hereinafter Pisutha-Arnond).

Regarding claim 36, Holmstrom differs from the claimed invention in not specifically teaching the user interface including voice activation application. However, it is old and notoriously well known in the art of inputting requests to a processor of a communication terminal via voice activation application, in order to make user friendly by providing efficient entry of information, for example see Pisutha-Arnond (page 28 lines 3-13). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to

modify Holmstrom in having the user interface including voice activation application, as per teaching of Pisutha-Arnond, because it makes friendly by providing efficient entry of information.

### ***Response to Arguments***

8. Applicant's arguments filed 2/28/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that Holmstrom fails to teach the automatic matching being prompted by entering one or two characters in a search box by the user, it is noted that Holmstrom clearly discloses to enter partial command or the initial or initials of the command or function name to find commands without knowing the full name of the function or commands (col. 5 lines 30-39 and col. 6 lines 31-49) so that the claimed invention could have been anticipated from Holmstrom.

9. Applicant's arguments with respect to claims 20-37 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

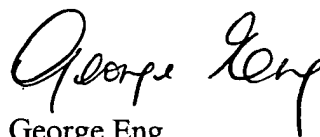
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tue-Fri 7:30 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "George Eng". The signature is fluid and cursive, with the first name "George" and the last name "Eng" clearly distinguishable.

George Eng  
Primary Examiner  
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